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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,085	09/26/2003	Jeffrey P. Rios	F-747	7507
919	7590	04/03/2007	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			VETTER, DANIEL	
			ART UNIT	PAPER NUMBER
			3628	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/03/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/673,085	RIOS ET AL.
	Examiner	Art Unit
	Daniel P. Vetter	3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 January 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4,6,8,13,15,20-22 and 24 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,6,8,13,15,20-22 and 24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 January 2007 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>1/8/2007</u>	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

Claims 5, 7, 9-12, 14, 16-19, 23, and 25-30 have been cancelled. Claims 1-4, 6, 8, 13, 15, 20-22, and 24 are pending in this application and are presented as amended for examination.

### *Response to Arguments*

1. The amendments to claims 8 and 15 have overcome their indefiniteness under 35 U.S.C. § 112, second paragraph, and as such these rejections are removed.
2. Applicant's arguments with respect to claims 1-4, 6, 8, 13, 15, 20-22, and 24 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 8, 13, 15, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaghi, U.S. Pat. No. 6,571,223 (Reference A of the

PTO-892 part of Paper No. 20061005) in view of Carbone, et al., U.S. Pat. No.

5,101,981 (Reference A of the attached PTO-892).

5. As per claims 1 and 13, Vaghi teaches means for and scanning the information printed on a mailpiece to obtain the postage data for the mailpiece (column 5, lines 6-7); means for and calculating the postage charge for the mailpiece based on the postage data obtained from the scanning the information printed on the mailpiece (column 5, lines 13-14); and means for and printing an indicia on the mailpiece that represents the calculated postage charge (column 5, lines 18-20). Vaghi does not teach means for and scanning to obtain the sequence data of the mailpiece; means for and determining if the sequence data for the mailpiece includes a container break indicator that signifies the mailpiece is a final mailpiece for a first container of the plurality of containers used to hold the batch of mailpieces; if the sequence data does not include a container break indicator, means for and depositing the mailpiece in the first container and accepting a next mailpiece for processing; and if the sequence data does include a container break indicator, means for and depositing the mailpiece in the first container and modifying operation of the mailing machine to deposit subsequent mailpieces in the batch of mailpieces into a second container of the plurality of containers used for holding mailpieces, wherein the predetermined sequence of the batch of mailpieces and the predetermined portion of the batch of mailpieces

in each of the plurality of containers is maintained. Carbone, et al. teaches means for and scanning to obtain the sequence data of the mailpiece (column 3, lines 55-60); means for and determining if the sequence data for the mailpiece includes a container break indicator that signifies the mailpiece is a final mailpiece for a first container of the plurality of containers used to hold the batch of mailpieces (column 4, lines 49-50); if the sequence data does not include a container break indicator, means for and depositing the mailpiece in the first container and accepting a next mailpiece for processing (column 6, lines 13-15); and if the sequence data does include a container break indicator, means for and depositing the mailpiece in the first container and modifying operation of the mailing machine to deposit subsequent mailpieces in the batch of mailpieces into a second container of the plurality of containers used for holding mailpieces (column 4, lines 35-38; 60-63), wherein the predetermined sequence of the batch of mailpieces and the predetermined portion of the batch of mailpieces in each of the plurality of containers is maintained (column 4, line 46). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate means for and scanning to obtain the sequence data of the mailpiece; means for and determining if the sequence data for the mailpiece includes a container break indicator that signifies the mailpiece is a final mailpiece for a first container of the plurality of containers used to hold the batch

of mailpieces; if the sequence data does not include a container break indicator, means for and depositing the mailpiece in the first container and accepting a next mailpiece for processing; and if the sequence data does include a container break indicator, means for and depositing the mailpiece in the first container and modifying operation of the mailing machine to deposit subsequent mailpieces in the batch of mailpieces into a second container of the plurality of containers used for holding mailpieces, wherein the predetermined sequence of the batch of mailpieces and the predetermined portion of the batch of mailpieces in each of the plurality of containers is maintained into the teachings of Vaghi in order to recognize breaks for sorting and taking advantage of bulk mailing discounts (as taught by Carbone, et al.; column 2, lines 5-9).

6. As per claims 2 and 20, Vaghi in view of Carbone, et al. teaches the method and machine of claims 1 and 13 as described above. Carbone, et al. further teaches modifying operation of the mailing machine includes means for and temporarily pausing operation of the mailing machine (column 5, lines 21-23). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate modifying operation of the mailing machine includes means for and temporarily pausing operation of the mailing machine into the teachings of Vaghi in view of Carbone, et al. in for removing mailpieces from the machine (as taught by Carbone, et al.; column 5, line 23). The limitation "to

allow the first container to be replaced by the second container" is merely a statement of intended use and not afforded patentable weight. Recitations of intended use are only afforded patentable weight to the extent that it results in structural differences between the claimed invention and the prior art.

7. As per claims 3 and 21, Vaghi in view of Carbone, et al. teaches the method and machine of claims 1 and 13 as described above. Vaghi further teaches the information is printed in barcode form (column 2, line 47).

8. As per claims 4 and 22, Vaghi in view of Carbone, et al. teaches the method and machine of claims 1 and 13 as described above. Vaghi further teaches the information is encoded (column 2, line 46).

9. As per claims 8 and 15, Vaghi in view of Carbone, et al. teaches the method and machine of claims 1 and 13 as described above. Vaghi further teaches means for and adding a surcharge to the postage charge for the mailpiece to account for additional services specified for the mailpiece in the postage data included in the information printed on the mailpiece (column 5, lines 49-52; column 6, lines 43-46).

10. Claims 6 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaghi in view of Carbone, et al. as applied to claims 1 and 13 above, in further view of Moed, et al., U.S. Pat. No. 5,770,841 (Reference B of the PTO-892 part of Paper No. 20061005).

11. As per claims 6 and 24, Vaghi in view of Carbone, et al. teaches the method and machine of claims 1 and 13 as described above. Vaghi in view of Carbone, et al. does not teach the information printed on the mailpiece uniquely identifies the mailpiece. Moed, et al. teaches the information printed on the mailpiece uniquely identifies the mailpiece (column 2, line 38). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the information printed on the mailpiece uniquely identifies the mailpiece in order to form a unified package record which may be used to sort and track the package (as taught by Moed, et al.; column 2, lines 45-48).

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Korowotny, U.S. Pat. No. 5,475,603 (Reference B of the attached PTO-892) teaches a method for providing dual sliding windows for the purpose of determining postage discount qualifications across invalid and unreadable mail pieces and determining the number of mail pieces to be placed in a mail tray for receiving the maximum postage discount. Delfer, et al., U.S. Pat. No. 5,754,434 (Reference C of the attached PTO-892) teaches a bulk mailing system for controlling and processing mailing envelopes containing selected combinations of documents and inserts comprises a programmable

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computer controller, a plurality of printers, a controller interfaced collator for merging document pages from the printers, a document folder, and a controller interfaced inserter for filling the mailing envelopes with the selected combinations of document pages and inserts. Bouchard, U.S. Pat. No. 5,841,658 (reference D of the attached PTO-892) teaches a method of automatically converting a random address file into a file with address entries in bulk mail order by package and sack groups, including postal endorsements used in a unique manner which indicates by a mere glance where mailpiece package groups separate; and a mailpiece count report which facilitates mailing statement preparation and postage calculation, and a mail sack label report which shows what must appear on each mail sack label needed for the mailing.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory

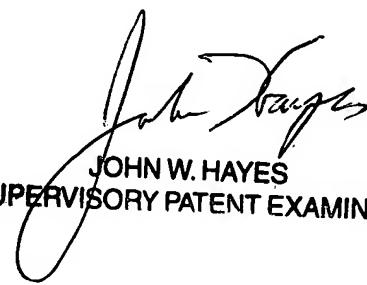
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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Vetter whose telephone number is (571) 270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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SUPERVISORY PATENT EXAMINER